

REMARKS

Claims 18-60 are pending, with claims 18, 25, 42, 59, and 60 being independent. Claims 18, 20, 25, 26, 27-30, 32, 34-41, 43, 45, 48, 51, 59, and 60 are amended.

Applicant would like to thank Examiner Nguyen and Examiner Woo for the telephonic interview conducted with the Applicant's representative, Kevin Greene, on April 21, 2005. During the interview, the rejections of claims 18, 25, 42, 59, and 60 as anticipated by U.S. Patent No. 3,906,954 (Baehr) and U.S. Patent No. 3,976,077 (Kerfoot) were discussed. In particular, the Examiners' application of these references to claims 18, 25, 42, 59, and 60 were discussed, as described further below.

Claims 18 and 60

Independent claim 18 is directed to a method of cutting including slicing into tissue with a helical knife to draw tissue proximally toward a sharp cutting edge, and cutting the tissue with the sharp cutting edge. The helical knife has a slicing edge extending through an opening at least partially bounded by the sharp cutting edge.

Independent claim 60 is directed to a method of cutting that includes slicing into tissue with a helical knife that extends through an opening of an outer member. The opening is at least partially bounded by a sharp cutting edge. This is followed by rotating the helical knife to draw the tissue toward the sharp cutting edge, which is followed by shearing the tissue between the helical knife and the sharp cutting edge.

Independent claims 18 and 60 stand rejected as anticipated by both Baehr and Kerfoot. Applicant requests that the rejection of claim 18 be withdrawn because these references do not describe or suggest at least slicing into tissue with a helical knife to draw tissue proximally toward a sharp cutting edge, as recited in claim 18. Similarly, Applicant requests that the rejection of claim 60 be withdrawn because these references do not describe or suggest at least an opening of an outer member at least partially bounded by a sharp cutting edge or rotating a helical knife to draw the tissue toward the sharp cutting edge, as recited in claim 60.

With respect to Baehr, in the Office Action, the Examiner equates the recited opening with the opening 21 and the recited cutting portion with the cutting tip 16 of rod 15. October 28th Office Action, Page 2, Lines 14-15 (“Baehr et al disclose . . . an outer member (20) has an opening (21) bounded by a cutting edge (16)”). During the interview, Applicant asked the Examiners to explain how the tip 16 of rod 15 at least partially bounds the opening 21.

In response, the Examiners indicated that they now consider the opening at the left end (as viewed in Figure 1) of tube 20 as being equivalent to the recited opening bounded by a cutting portion. Further, during the interview, the Examiners asserted that the end portion of tube 20 defining the opening could act as a cutting portion, even though this end portion is blunt. Lastly, the Examiners asserted that, during operation, the cutting tip 16 of rod 15 would engage tissue and the tissue would inherently be drawn by screw portion 17 toward the end of tube 20, where a shearing action between the screw portion 17 and the end of tube 20 would inherently take place.

Applicant does not concede that such actions would inherently occur during the operation of the device 10. However, to move forward prosecution, Applicant has amended claim 18 to recite a “sharp cutting edge.” The end portion of tube 20 in Baehr is apparently blunt, as best seen in figure 1. Accordingly, even if device 10 inherently draws tissue toward the end of tube 20 during operation, which Applicant does not concede, Baehr does not describe or suggest at least “slicing into tissue with a helical knife to draw tissue proximally toward a sharp cutting edge,” as recited in claim 18, or “rotating the helical knife to draw the tissue toward the sharp cutting edge,” as recited in claim 60.

With respect to Kerfoot, in the Office Action, the Examiner equates the recited opening with opening 26 and the recited cutting portion with the tip of segment 24 in figure 2. October 28th Office Action, Page 3, Lines 12-14 (“Kerfoot et al disclose . . . an opening (26) bounded by a cutting edge (the cutting edge is considered at the tip of segment 24 in fig. 2)”). However, similar to Baehr, the tip of segment 24 is apparently blunt, as best seen in figure 3. Accordingly, as with Baehr, even if the device of Kerfoot inherently draws tissue toward the tip of segment 24 during operation, which Applicant does not concede, Kerfoot does not describe or suggest

“slicing into tissue with a helical knife to draw tissue proximally toward a sharp cutting edge,” as recited in claim 18, or “rotating the helical knife to draw the tissue toward the sharp cutting edge,” as recited in claim 60.

Therefore, for at least the foregoing reasons, Applicant respectfully requests that the rejection of independent claims 18 and 60, and those claims that depend from them, be withdrawn.

Claims 25 and 59

Claims 25 and 59 both recite, in part, a cutting instrument including an outer member having an opening at least partially bounded by a sharp cutting edge. These claims stand rejected as anticipated by both Baehr and Kerfoot. Applicant requests that these rejections be withdrawn because these references do not describe or suggest at least an outer member having an opening at least partially bounded by a sharp cutting edge.

As described above, in Baehr, the end portion of tube 20 is apparently blunt, as best seen in figure 1. Similarly, in Kerfoot, the tip of segment 24 is apparently blunt, as best seen in figure 3. Accordingly, neither Baehr or Kerfoot describe or suggest “an opening at least partially bounded by a sharp cutting edge,” as recited in claims 25 and 59.

Therefore, for at least the foregoing reasons, Applicant respectfully requests that the rejections of independent claims 25 and 59, and the claims that depend from them, be withdrawn.

Claim 42

Independent claim 42 is directed to a cutting instrument that includes an outer member having an opening at least partially bounded by a cutting edge and an inner member received in the outer member for rotation relative to the outer member. The inner member includes a shaft having a helical knife with a V-shaped cross section defining a sharp, slicing edge.

Claim 42 stands rejected as anticipated by both Baehr and Kerfoot. Applicant requests that these rejections be withdrawn.

The Examiner has failed to establish a *prima facie* case of anticipation. In particular, in the Office Action, the Examiner does not address claim 42's recitation of "a helical knife with a V-shaped cross section defining a sharp, slicing edge." During the interview, neither Examiner provided an explanation of how either Baehr or Kerfoot anticipates this claim language, and indicated that they would need to further consider these references.

Furthermore, Applicant submits that neither Baehr nor Kerfoot describes or suggests "a helical knife with a V-shaped cross section defining a sharp, slicing edge," as recited in claim 42.

With respect to Baehr, in the Office Action, the Examiner equates screw portion 17 with the recited helical knife. October 28th Office Action, Page 2, Line 13-16 ("Baehr et al disclose . . . a helical knife (17)"). However, the edge of the screw portion 17 in Baehr is apparently blunted, as best seen in figure 1. Therefore, screw portion 17 does not have a V-shaped cross section defining a sharp, slicing edge. Accordingly, Baehr does not describe or suggest a "helical knife with a V-shaped cross section defining a sharp, slicing edge," as recited in claim 42.

With respect to Kerfoot, in the Office Action, the Examiner equates tool 30 with the recited helical knife. October 28th Office Action, Page 3, Lines 11-15 ("Kerfoot et al disclose . . . a helical knife (30)"). However, the edge of the tool 30 in Kerfoot is apparently blunted, as best seen in figure 3. Therefore, tool 30 does not have a V-shaped cross section defining a sharp, slicing edge. Accordingly, Baehr does not describe or suggest a "helical knife with a V-shaped cross section defining a sharp, slicing edge," as recited in claim 42.

Therefore, for at least the foregoing reasons, Applicant respectfully requests that the rejection of independent claim 42, and those claims that depend from it, be withdrawn.

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Enclosed is a \$1020.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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